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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,166	10/03/2003	David C. Szakelyhidi JR.	34548.208	3958

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EXAMINER	
WOODALL, NICHOLAS W	
ART UNIT	PAPER NUMBER
3733	

MAIL DATE	DELIVERY MODE
07/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/679,166	SZAKELYHIDI ET AL.	
	Examiner	Art Unit	
	Nicholas Woodall	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14,18-22,26-28,30-34,37,39-47,49-51 and 53-66* is/are pending in the application.

4a) Of the above claim(s) *19-22,26-28,30-33 and 56-66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14,18,34,37,39-47,49-51 and 53-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on 04/03/2008.

Response to Amendment

2. The declaration filed on 04/03/2008 under 37 CFR 1.131 is sufficient to overcome the Govari (U.S. Publication 2005/0080427) reference.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, 9, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Durham (U.S. Patent 6,162,228).

Durham discloses a device comprising a cylindrical magnet positioned on an insertion rod positioned within a longitudinal opening of an intramedullary nail and held at a fixed position within the longitudinal opening of the intramedullary nail at a discrete position adjacent to a transverse screw hole in the intramedullary nail, a target comprising a sensor for sensing the three-dimensional orientation of a magnet, at least one drill sleeve that receives and aligns a drill bit with a transverse screw hole in the intramedullary nail, and a handle holding the sensor and the drill sleeve. The magnet provides a non-uniform and non-circular three-dimensional magnetic field oriented on an x-axis, y-axis, and a z-axis that is strong enough to be sensed by the sensor of the target, wherein the magnet is polarized along the longitudinal axis of the magnet. The

examiner believes that Figure 6 of the reference shows the magnet having a non-uniform magnetic field, i.e. not the same strength in all directions, wherein the fields are symmetrical about the longitudinal axis of the magnet, i.e. polarized along the longitudinal axis of the magnet. The sensor comprises at least one sensor (28 and 28a) that detects the magnetic flux lines of the magnet.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228).

Durham discloses the invention as claimed except for the magnet having a diameter of less than about 4 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the magnet with a diameter less than about 4 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228) in view of Durham (U.S. Patent 5,049,151).

Durham discloses the invention as claimed except for the magnet being made from Neodymium Iron Boron. Durham teaches a device comprising a magnet made

from Neodymium Iron Boron in order to provide a very strong magnet (column 9 lines 24-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Durham comprising a magnet made from Neodymium Iron Boron in view of Durham in order to provide a very strong magnet.

8. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228) in view of Hollis (U.S. Patent 6,081,741).

Durham discloses the invention as claimed except for the target comprising a readable display. Durham discloses a target comprising a display in order to display the orientation of the sensor. Hollis discloses a device including a target comprising a sensor and a readable display including LED displays having several LED lights in order to display the orientation of the sensor. Because both Durham and Hollis disclose devices comprising displays, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one display for the other in order to achieve the predictable results of displaying the orientation of the sensor.

9. Claims 11, 12, 34, 37, 39-43, 47, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228) in view of Admission (Applicant's Arguments/Response received on 07/09/2007).

Durham discloses the invention as claimed except for the sensor comprising an elliptical array of four pairs of sensors, the magnetic field being sensed by the sensor at a distance of about 10 cm, the magnet having a diameter of less than about 4 mm, and the device comprising two drill sleeves. The applicant admitted in the applicant's arguments/response received on 07/09/2007 that the sensor comprising an elliptical

array of four pairs of sensors is an obvious variation to the device (page 1 lines 16-28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Durham having a sensor comprising an elliptical array of four pairs of sensors in view of the applicant's own admission of obviousness. Regarding the magnetic field being sensed by the sensor at a distance of about 10 cm and the magnet having a diameter of less than about 4 mm, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a magnetic field that is sensed by the senor at a distance of about 10 cm and the magnet having a diameter less than about 4 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Regarding the device further comprising a second drill sleeve, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Durham with a second drill sleeve, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

10. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228) in view of Admission (Applicant's Arguments/Response received on 07/09/2007) further in view of Durham (U.S. Patent 5,049,151).

The device of Durham as modified by the applicant's admission discloses the invention as claimed except for the magnet being made from Neodymium Iron Boron. Durham teaches a device comprising a magnet made from Neodymium Iron Boron in

order to provide a very strong magnet (column 9 lines 24-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Durham as modified by the applicant's admission comprising a magnet made from Neodymium Iron Boron in view of Durham in order to provide a very strong magnet.

11. Claims 49, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham (U.S. Patent 6,162,228) in view of Admission (Applicant's Arguments/Response received on 07/09/2007) further in view of Hollis (U.S. Patent 6,081,741).

The device of Durham as modified by the applicant's admission discloses the invention as claimed except for the target comprising a readable display. The device of Durham as modified by the applicant's admission discloses a target comprising a display in order to display the orientation of the sensor. Hollis discloses a device including a target comprising a sensor and a readable display including LED displays having several LED lights in order to display the orientation of the sensor. Because both the device of Durham as modified by the applicant's admission and Hollis disclose devices comprising displays, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one display for the other in order to achieve the predictable results of displaying the orientation of the sensor.

Response to Arguments

12. Applicant's arguments with respect to claims 1-12, 14, 18, 34, 37, 39-47, 49-51, and 53-55 have been considered but are moot in view of the new ground(s) of rejection.

The examiner has presented new grounds of rejection not necessitated by the amendment making this office action non-final.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3733

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731